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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,178	07/26/2001	Edward Baranoff	602936.1019	7114

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ABELMAN, FRAYNE & SCHWAB  
Attorneys at Law  
666 Third Avenue  
New York, NY 10017-5621

EXAMINER

POLLI COFF, STEVEN B

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,178

Applicant(s)

BARANOFF, EDWARD

Examiner

Steven B. Pollicoff

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 3 is objected to because of the following informalities: Spelling error on line 1: "accarding" should read "according". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster et al., (U.S. Pat. No. 6,073,758) in view of Sperandio (U.S. Pat. No. Des. 343,140).

With respect to claims 1, 11 and 12, Webster discloses a display package comprising a fold-over card formed from a single elongated strip (see Webster Fig. 1) folded at the bottom to define front and rear panels (see Fig. 4, reference numbers 28 and 29, respectively; see also Column 3, Lines 29-32) joined by a neck (see Fig. 1,

reference number 20) at the bottom, said panels together defining a flat first plane (Fig 4 at reference number 16), each of said panels having near its top edge a through hole (see Fig. 1, reference number 18), and said holes becoming aligned when said panels are folded to overlies each other (see Column 2, Lines 58-61). Webster also discloses a single support loop/wire-like element formed as a closed loop (a necklace or bracelet according to Webster) (see Fig. 3, reference number 12) which defines a second plane, said loop having top and bottom parts (see Fig. 4 generally), the top part lying in said neck (see Fig. 3 at reference number 24), said bottom part situated below said neck (see Fig. 4 generally), and said plane of said loop being generally coplanar with said plane of said panels (see Fig. 4, generally).

Webster does not disclose that a plurality of ring-shaped holders extend through the support loop/wire-like element such that the ring-shaped holders hang below the fold-over card or that each ring-shaped ponytail holder defines a third plane situated generally perpendicular/not coplanar to the first plane of the panels of the fold-over card. However, Sperandio discloses a necklace defined as a support loop/wire-like element (see Sperandio Fig. 1, generally) and a pendant holder defined as a ring-shaped holder (capable of being a ponytail holder) wherein the support loop/wire-like element extends through the bore of the holder so that it does not disengage from the support loop. The holder is also capable of defining a plane perpendicular/not coplanar to the plane of the support loop (see Sperandio Fig. 3 generally). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the support loop (i.e. necklace or a bracelet) of Webster with the support loop

and ring shaped holder (i.e. necklace with pendant holder) of Sperandio for the purpose of giving consumers a variety of merchandise options at the store. Additionally, while Sperandio only discloses one ring-shaped holder on the support loop, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a plurality of ring-shaped holders, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case it is common for necklaces/ bracelets to have a plurality pendants at any one time and thus the need for a plurality of ring-shaped holders.

As to Claims 2 and 3, Webster discloses that when the package is suspended, the panels when folded to overlies each other are generally parallel and define the first plane (see Webster Fig. 4 generally). Webster does not disclose that the ponytail holders each define a plane generally perpendicular to the vertical plane of the panels. However, Sperandio discloses that the holder defines a plane perpendicular to the plane of the support loop, which is parallel to the plane of the panels disclosed in Webster (see Sperandio Fig. 3 generally). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the Webster support loop with the support loop with the perpendicular ring-shaped holder of Sperandio, for the purpose of better visual display characteristics of the pendant when displayed for purchase.

As to Claim 4, when the Webster support loop is replaced with the Sperandio support loop with ring-shaped holder in the Webster display package, it would be

obvious that the holders would be positioned below the folded panels and generally centered.

As to Claim 5, Webster discloses that the through holes (apertures) of the front and rear panels are situated midway of the length of the panels from left to right (see Webster Fig. 1).

As to Claim 7, Webster discloses that the front and rear panels have generally the same length and height (see Webster Fig. 1).

As to Claim 8, Webster discloses that the strip comprises a plastic sheet (see Webster Column 2, Lines 46-49).

As to Claim 9, Webster discloses that the strip comprises cardboard (see Webster Column 2, Lines 46-49).

As to Claim 10, Webster discloses that the panels lie generally flat against each other (see Webster Fig. 4).

### ***Response to Arguments***

Applicant's arguments filed 4/19/06 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is within the

common knowledge of those with ordinary skill in the art to replace one kind of necklace (support loop) in a display package with another kind of necklace (support loop).

Additionally, Applicant's argument that combining Webster with Sperandio would result in structure different from the limitations recited in claim 1 is unpersuasive because all of the structural limitations are met with the combination and any additional structures present on the combination does not make the rejection improper. Applicant argues that Webster does not teach that the plane of the support loop and plane of the card are coplanar because the support loop of Webster traverses aperture 22. However, a quick review of Webster Fig.4 clearly shows that the support loop (not labeled) is coplanar with the plane of the card (28 and 29) when compared with Applicant's Fig. 2. In response to applicant's argument that the prior art does not teach the concept of the present invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, not only does the prior art seem to meet the structural limitations of the present invention, it is also capable of performing the intended use of the holder.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be



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SBP 6/26/06  
SBP



**JILA M. MOHANDESI**  
**PRIMARY EXAMINER**